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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,123	07/10/2000	William N. Schilit	FXPL-01022US0 MCF/TAW	8793
23910	7590	03/10/2004	EXAMINER HALIM, SAHERA	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			ART UNIT 2157	

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,123

Applicant(s)

SCHILIT ET AL.

Examiner

Sahera Halim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to communication filed on December 15, 2003.

Claim Objections

2. Claim 9 is objected to because of the following informalities: the claim has grammar error. It recites "the at least one telephone numbers" in line 6 and 7 of the claim. They are assumed to be "the at least one telephone number", for examination purposes. Appropriate correction is required.
3. Regarding claims 10 and 11 are objected to because of the following informalities: claims 10 and 11 have an indication in parentheses that the claims are in original form. However, the body of the claims has been amended. It is assumed that the claims have been amended and the amended claims have been presented for examination. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is unclear because web content does not have any connection to the data portion or to the data file (web page).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by De Boor et al., U.S. Pat. No. 6,675,204 (hereinafter Boor).

8. Reference to claim 9, Boor discloses a method for providing telephone access using Web page information comprising the step of (abstract):

receiving a URL from a user (col. 4, lines 18 - 46);

accessing a Web page data file identified by the URL (col. 4, lines 28 - 46);

identifying at least one telephone number from the content in the Web page (col. 4, lines 47 – col. 5, line 48 and col. 13, lines 26 - 51);

displaying the at least one telephone number for the user (col. 4, lines 47 – col. 5, line 48 and col. 13, lines 26 - 51); and

providing a user keypad selection enabling a selected one of the at least one telephone number to be dialed (col. 4, lines 47 – col. 5, line 48, Fig. 1, col. 9, lines 34 – 49, and col. 13, lines 26 - 51).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Boor et al., U.S. Pat. No. 6,675,204 (hereinafter Boor) in view of Horowitz et al., U.S. Pat. No. 6,122,647 (hereinafter Horowitz).

11. Regarding claim 1, Boor discloses a method for proving data detection from Web content information for mobile devices comprising (abstract):

receiving a URL from a user (col. 4, lines 7 - 46);

accessing a Web page data file identified by the URL (col. 4, lines 7 - 46);

Boor fails to disclose detecting a data portion from the Web page data file, the data portion adapted to be enhanced by introducing a link indication to a service;

identifying Web content data, the web content data adapted to be accessed to provide a link service from a mobile device through a wireless connection;

displaying the identified web content data using the link indication on a display.

However, Horowitz teaches detecting a data portion from the Web page data file, the data portion adapted to be enhanced by introducing a link indication to a service (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d);

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identifying Web content data, the web content data adapted to be accessed to provide a link service from a device (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d);

displaying the identified web content data using the link indication on a display (col. 7, line 1 – col. 8, line 37 and Fig 4a – 4d).

It would have been obvious for person having ordinary skill in the art at the time of the invention to combine Boor and Horowitz teachings in order to allow easy access of content from mobile devices (Boor, col. 1 line 22 – col. 2, line 28).

12. Regarding claim 2, Boor teaches the steps of providing a user keypad selection enabling the link indication to be activated; and using the wireless connection to activate the link indication when the user keypad selection is made (col. 1, lines 64 – col. 2, lines 28, col. 6, lines 39 – col. 7, lines 39) .

13. Regarding claim 3, Boor discloses the Web content data is a telephone number, (col. 13, lines 28 – line 58).

14. Reference to claim 4, Boor and Horowitz fail to teach the link indication is activated by dialing the number. However, this feature is well known and would have been an obvious modification for person having ordinary skill in the art at the time of the invention to in order to reduce the steps of dialing a number.

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15. Regarding claim 5, Boor discloses the web content data is an address number (col. 13, lines 28 – line 58).

16. Reference to claim 6, Boor and Horowitz do not teach the link indication is activated by obtaining map data showing a location for the address. However, this is an obvious modifications to the systems discloses by Boor and Horowitz. It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Horowitz and Boor by providing a link to an address and then mapping the location in order to simplify the complexity of the system and increase user satisfaction by enabling the user to retrieve needed information from the same web page.

17. Regarding claim 7, Boor discloses the Web content data is an e-mail address (col. 13, lines 28 – line 58).

18. Reference to claim 8, Boors and Horowitz do not disclose the link indication is activated to enable the e-mail to be initiated. However, this feature is well known and would have been an obvious modification for person having ordinary skill in the art at the time of the invention to in order to reduce the steps of initiating e-mails.

19. Regarding claim 12, Boor discloses the display is provided on a device consisting of one or more of the following:

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an Internet phone (col. 13, lines 28 – line 58, col. 4, lines 47 – 62 and col. 8 lines 41 – col. 9, lines 55);

a personal digital assistant (col. 13, lines 28 – line 58); and

a two way pager (col. 13, lines 28 – line 58).

20. Reference to claims 13 and 14, Boor teaches the detection occurs in a network server and within a Web browser (col. 9 lines 58 – col. 11, line 53).

21. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boor.

22. Regarding claim 10, Boor discloses receiving a URL from a user (col. 4, lines 18 - 46);
accessing a Web page data file identified by the URL (col. 4, lines 28 - 46);
identifying at least one address from the content in the Web page (col. 13, lines 26 – 51);
displaying the identified address for the user (col. 13, lines 26 – 51);
providing a user keypad selection of a mobile device (Fig.1, col. 9, lines 34 – 49 and col. 4, lines 18 – 46).

Boor does not teach a map to be provided showing a location for the identified address. However, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Boor by providing a map for the identified address in order to increase user satisfaction by providing more information.

23. Regarding claim 11, Boor discloses receiving a URL from a user (col. 4, lines 18 - 46);

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accessing a Web page data file identified by the URL (col. 4, lines 28 - 46);
identifying at least one email address from the content in the Web page (col. 13, lines 26 – 51);
displaying the identified email address for the user (col. 13, lines 26 – 51);
providing a user keypad selection of a mobile device (Fig. 1, col. 9, lines 34 – 49 and col. 4, lines 18 – 46).

Nonetheless Boor does not disclose an email initiation. However, email initiation is well known in the art and it would have been an obvious modification to the system disclosed by Boor in order to enhance user stratification by providing more functionality to the system.

Response to Arguments

24. Applicant's arguments filed December 15, 2003 have been fully considered but they are not persuasive.

25. It is argued that Horowitz does not disclose a method intended for use with mobile devices. Since the primary reference Boor disclose a method intended for use with mobile devices, Horowitz does not have to address this limitation. Moreover, it is argued “the hyperlinks provided by Horowitz are associated with more content, not a service”. Providing more content is a service. Since the claims do not define a service, it is an examiner’s duty to interpret the claims in its broadest form. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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26. Applicant's arguments with respect to claims 9-11, have been considered but are moot in view of the new ground(s) of rejection.

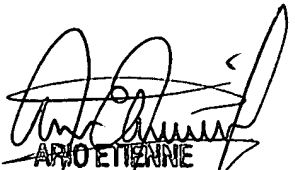
Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (703) 305-8054. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim
Patent Examiner
AU: 2157
March 3, 2004


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